

REMARKS

After the foregoing amendment, claims 1-3, 8 and 10-32, as amended, are pending in the application. Claims 1-3, 8, 10-11, 13, 16-18 and 20-24 have been amended to more particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 4-7 and 9 have been canceled. Claims 8-10 have been rewritten as new claims 25-27 incorporating all the limitations of claim 3 and the intervening claims. Claims 20-24 have been rewritten as new claims 28-32 incorporating all the limitations of claim 18 and the intervening claims. Applicants submit that no new matter has been added to the application by the Amendment.

Rejection - 35 U.S.C. § 102

The Examiner rejected claims 1-7 and 11-18 under 35 U.S.C. § 102 as being unpatentable over U.S. Patent No. 6,424,605. Applicants have amended claims 1-3 and 16-18 and therefore respectfully traverse the rejection.

Iida discloses a method and apparatus for discriminating between two types of discs, a CD or CD-R and a DVD. As described at col. 11, line 59 to col. 13 line 46 and Fig. 9, Iida discloses a method whereby upon insertion of a disc, the apparatus is placed in a CD pickup mode. The apparatus then attempts to focus and to track the disc. If either the apparatus can not be focused, or the focus error is above a certain level or the tracking level is above a certain level, the disc is judged to be a DVD and not either a CD or a CD-R.

Note importantly that Iida's method is unable to distinguish between a CD and a CD-R. This is because a CD and a CD-R each have a signal plane located near the extremity of the disc (see col. 5, lines 3-9) and the density of the recording pits is identical in the CD and the CD-R. Thus a test for distinguishing between a CD and a CD-R based only on focus and tracking must, by necessity, fail.

"Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) MPEP § 2111.02, August 2006.

Amended claim 1 recites inter-alia, "A method for recognizing at least three types of optical discs...." The amendment to claim 1 reads on the second embodiment of the invention

which is described at paragraphs [0133] – [0154] and which includes the statement at paragraph [0136] that the method of recognition for embodiment two is the same as for the first embodiment. The recognition of three types of discs by the first embodiment is shown by Figs. 8 and 10. Further amendments to claim 1 are supported at paragraphs [0145] to [0147] of the application.

Applicants submit that Iida discloses a method for recognizing only two types of discs. This is clearly shown by: (1) The flowchart shown in Fig. 9 of Iida, describing the distinguishing operations of Iida's invention, which shows only two outputs: (1) a CD/CD-R output and (2) a DVD output and (2) because of the logic performed by Iida, it is not possible for Iida to discriminate among more than two types of discs, as the tests only provide for determining whether the inserted disk is a CD or CD-R and if it is not a CD or a CD-R, the output defaults to a second type, i.e. a DVD.

Amended claim 1 recites recognizing at least three types of discs, thereby limiting the scope of amended claim 1 to methods capable of recognizing at least three types of discs. Accordingly, because Iida discloses recognizing only two types of discs, Applicants respectfully request reconsideration and withdrawal of the §102 rejection of claim 1.

Amended claims 2, 3 and 16-18 are allowable for the same reasons that claim 1 is allowable. Further, claims 11-15 are allowable, at least by their dependency on allowable claim 3. Accordingly, Applicants respectfully request reconsideration and withdrawal of the §102 rejection of claims 1-3 and 11-15.

Rejection - 35 U.S.C. § 103

The Examiner rejected claim 19 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,424,605 (Iida) in view of U.S. Patent No. 5,671,203 (Ra). Applicants respectfully traverse the rejection.

Claim 19 depends from allowable claim 18. Ra does not teach, suggest or disclose the missing element of claim 18, i.e. accessing at least three types of discs. Accordingly, claim 19 is allowable, at least by its dependency on claim 18. Accordingly Applicants respectfully request reconsideration and withdrawal of the §103 rejection of claim 19.

Allowable Subject Matter

The Examiner objected to claims 8-9 and 20-24 as being dependent upon a rejected base claim but stated that claims 8-9 and 20-24 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Applicants have amended claim 8 to include all the limitations of claims 3 and 5 from which it depends, and rewritten claim 8 as new claim 25. Claims 9 and 10 depend directly from claim 8 and are rewritten as new claims 26 and 27. Applicant has also amended claim 20 to include all the limitations of claim 19 from which it depends and rewritten claim 20 as new claim 28. Claims 21-24, depending from claim 20, are rewritten as new claims 29-32 depending from new claim 28. Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection to claims 8-9 (and 10) and 20-24 as the objection may be applied to new claims 25-32.

Conclusion

Insofar as the Examiner's objections and rejections have been fully addressed, the instant application, including claims 1-3, 8 and 10-32, is in condition for allowance and Notice of Allowability of claims 1-3, 8 and 10-32 is therefore earnestly solicited.

Respectfully submitted,

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(Date)

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